

ARGUMENTS/REMARKS

Applicants would like to thank the examiner for the careful consideration given the present application. The application has been carefully reviewed in light of the Office action, and favorable reconsideration of the subject application is requested in view of the comments and/or amendments made herein.

Claims 36-80 remain in this application.

Claims 39-40, 42-45, 47-49, 56-57, 65-67, 69-70 and 79-80 were rejected under 35 U.S.C. §102(b) as being anticipated by Smithers (U.S. 3,978,642). Claims 37, 52, 58, 62, 71, and 75 were rejected under 35 U.S.C. §103(a) as being unpatentable over Smithers in view of Mally (U.S. 5,391,386). Claims 54, 64 and 77 are rejected as above in further view of LaPlace (U.S. 6,595,739), whereas claims 53, 63, and 76 are rejected as above in further view of Wadell (U.S. 5,336,502). For the following reasons, the rejections are respectfully traversed.

Claim 36 recites a vacuum feeder system comprising a transfer device including:

a cylinder body that can be rotated, wherein said cylinder body is provided with a plurality of holes through an outer surface of said cylinder body; and

a plurality of vacuum connection means provided inside said cylinder body for connecting said vacuum interface to said holes, wherein

said transfer device transfers the materials or pieces from the first transport means to the second transport means or to said weighing system by rotating said cylinder body while the materials or pieces are held in place by a vacuum provided at holes in communication with the materials or pieces.

Smithers, cited by the Examiner for such a teaching, fails to teach any transfer of the materials or pieces from “the first transport means to the second transport means or to said weighing system by rotating said cylinder body while the materials or pieces are held in place by a vacuum provided at holes in communication with the materials or pieces”. Instead, Smithers teaches that a *film material 49* is held in place by a vacuum (col. 3, lines 20-52), and the slices of meat are placed on top of the film material (not on top of any

vacuum ports), and that the slices are held in place by contact with the *film*, not by a vacuum (col. 4, lines 22-31). Thus, the reference *fails* to teach that the materials or pieces are held in place by a *vacuum*, as required by the claim, and therefore the reference fails to anticipate the claim, and hence claim 36 is patentable over the reference. The remaining cited references fail to overcome the Smithers shortcomings, and thus claims 37-54, which depend on claim 36, are patentable over the references for at least the same reason as claim 36.

Claim 55 recites a feature of a “transfer device” which “transfers the materials or pieces from the first transport means to the second transport means or to the weighing system by rotating the cylinder body and by utilizing vacuum at said first holes for holding said materials or pieces”, and thus is patentable over the references for reasons similar to claim 36, as are claims 56-67, which depend on claim 55.

Claim 68 recites a transfer device which “transfers the materials or pieces from the first transport means to the second transport means or to the weighing system by rotating the cylinder body and by utilizing vacuum at said first holes for holding said materials or pieces”, and thus claim 68, along with claims 69-80 which depend on claim 68, are patentable over the references for similar reasons.

Further, the Examiner has not provided the proper motivation for combining the references. The burden is on the Examiner to make a *prima facie* case of obviousness (MPEP §2142). To support a *prima facie* case of obviousness, the Examiner must show that there is some suggestion or motivation to modify the reference (MPEP §2143.01), or some other recognized reason to make the proposed modification.

The Examiner has cited no support for any such suggestion or motivation for the combination from within the references, and neither does the Examiner provide any references or arguments based on the skill of the art supporting the recommended modifications. Merely listing an advantage or benefit of the combination, or arguing that such choices are merely “design choices” is not sufficient, as some rationale for combining the references must be found in the references themselves, or drawn from a convincing line of reasoning based on established scientific principles practiced by one skilled in the art that some advantage or beneficial result would be produced by the combination (MPEP

§2144). Such motivation cannot be found in the application itself, as such hindsight is impermissible; the facts must be gleaned from the prior art. (MPEP §2142, last paragraph).

“To reach a proper determination under 35 U.S.C. 103, the examiner must step backward in time and into the shoes worn by the hypothetical ‘person of ordinary skill in the art’ when the invention was unknown and just before it was made [and] the examiner must then make a determination whether the claimed invention ‘as a whole’ would have been obvious at that time to that person.” (MPEP §2142, emphasis added). It is not proper to merely combine various elements from various references. The invention must be obvious “as a whole”, not as a piecemeal combination of elements from various references.

Applicant notes that the benefits of the proposed modifications suggested by the Examiner are conclusory statements based, apparently, on the application itself and thus are examples of improper hindsight reasoning. The Examiner must provide some rationale as to why the particular choices provided in the claims would be selected by one skilled in the art. No such rationale has been provided, and thus the Examiner has failed to provide a *prima facie* case for obviousness and thus the rejection is improper, and should be withdrawn.

In consideration of the foregoing analysis, it is respectfully submitted that the present application is in a condition for allowance and notice to that effect is hereby requested. If it is determined that the application is not in a condition for allowance, the examiner is invited to initiate a telephone interview with the undersigned attorney to expedite prosecution of the present application.

If there are any additional fees resulting from this communication, please charge same to our Deposit Account No. 16-0820, our Order No. SCAN1-40146.

Respectfully submitted,
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Date: November 16, 2009

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